<u>REMARKS</u>

The Application has been carefully reviewed in light of the Office Action dated February 6, 2004 (Paper No. 11). Claims 1 to 19 are in the application, of which Claims 1, 4, 5, 6, 10, 13 and 15 are the independent claims. Claims 1 and 6 are being amended, and Claims 17 to 19 are being added. Reconsideration and further examination are respectfully requested.

Claims 1 to 3, 6 to 16 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,671,818 (Mikurak), and Claims 4 and 5 are rejected under 35 U.S.C. § 102(e) over Mikurak. Reconsideration and withdrawal of the rejections are respectfully requested.

The present invention generally concerns facilitating data searches using a portable interface, the portable interface stores data filter parameters used to reduce a search space in a search operation. The interface includes a smartcard, which is adapted to store the data filter parameters and has a user interface including selectable icons. The smartcard is inserted in a reader, in a manner allowing the icons to be visible and selectable. A user's icon selection is detected, and a reduced search space is in turn established based on the detected icon selection and a data filter parameter. The user is able to perform one or more database searches and data item selections using the PCFI.

By virtue of this arrangement, the smartcard user is able to use a programmable smart card to access filtering functions using a user interface provided by the smart card to reduce a search space. In addition, the user is able to perform database searches and/or to select data items via the user selectable icons accessible using the smartcard.

- 10 -

Turning to the specific language of the claims, Claim 1 is directed to a customisable data filter system adapted to reduce a dimension of a searchable data base and to perform one or more of a database search and a data item selection, in relation to a correspondingly reduced search space. The system comprises a Portable Customisable data Filter and Interface (PCFI), a reader means, and a data processing means. The PCFI comprises a programmable smartcard adapted to store at least a data filter parameter, and further adapted to provide a user interface by means of spatially distributed user selectable icons made visible on a surface of the smartcard. The reader means is adapted to interface with the PCFI, and further adapted to discriminate an icon on an inserted smartcard selected by a user. The data processing means, which is adapted to interface with the reader means, is (a) responsive to the data filter parameter stored in said PCFI and detected icon selection, and is (b) adapted to establish the correspondingly reduced search space dependent upon the filter parameter, wherein said one or more of the database search and the data item selection is performed using the user selectable icons.

It is conceded in the Office Action that Mikurak fails to teach each and every feature of Claims 1 to 3 and 6 to 16. In addition, Mikurak is the only reference identified in the rejection, and no reliance is made on general knowledge. Based on MPEP § 2142 et seq., it is submitted that a prima facie case of obviousness under 35 U.S.C. § 103(a) has not been established. Withdrawal of the rejection under 35 U.S.C. § 103(a) is accordingly respectfully requested.

More particularly, MPEP § 2142, et seq. states that, among the criteria for establishing a prima facie case of obviousness under 35 U.S.C. § 103(a), each and every

limitation of the claims must be found in the prior art, and not based on applicants'

disclosure. Since it is conceded in the Office Action that Mikurak fails to teach each and

every limitation, and no additional art is identified, it is believed that the burden of

establishing a prima facie case of obviousness has not been met in the Office Action. In

addition, there must be a reasonable expectation of success, and there must be some

showing of a suggestion found in the prior art reference or in knowledge generally

available to modify the teachings of Mikurak. Such suggestion cannot be based on

applicant's own disclosure. Since it is believed that the requisite evidence needed to

establish a prima facie case has not been shown in the Office Action, withdrawal of the

rejection is respectfully requested.

In addition to the legal insufficiencies noted above, it is also submitted that

the rejection based on Mikurak is technologically lacking, since Mikurak is not seen to

disclose the present invention, at least with respect to a smartcard which stores a data filter

parameter in a portable interface comprising a programmed smartcard with at least one

stored data filter parameter, user selectable icons are visible on the surface of the

smartcard, wherein a data processing means, which is responsive to a data filter parameter

stored by the portable interface and a detected icon selection to establish a reduced search

space dependent on the filter parameter, and wherein one or more of a database search and

a data item selection is performed.

Mikurak is seen to describe managing components (i.e., packet-switched

and circuit-switched components) of a network, the network for use in eCommerce

applications. With reference to col. 256, lines 25 to 30 of Mikurak cited in the Office

Action, a smartcard is merely used to store payment information. While Mikurak discusses filtering content, nothing in the cited portions of Mikurak is seen to disclose storing data filter parameters in an interface, which includes a smartcard having visible icons for selection by a user.

Therefore, for at least the foregoing reasons, Claim 1 is believed to be in condition for allowance. Further, Applicants submit that Claims 10, 13 and 15 are believed to be in condition for allowance for at least the same reasons.

Claim 4 defines a method of customising a Portable Customisable data Filter and Interface (PCFI) adapted to reduce a database search space, using a Portable Customisable User Interface (PCUI), wherein the PCFI and the PCUI respectively comprise a programmable smartcard providing a user interface including spatially distributed user selectable icons made visible on a surface of the smartcard, wherein the user selectable icons are operable using a smartcard reader to which the smartcard is connected. In an interfacing step of the method, a customizing system is interfaced to the PCFI and the PCUI using respective said smartcard readers. According to the method, the PCFI is programmed by means of user instructions input to the customizing system using the user interface of the PCUI.

Based on the above discussion, Mikurak is not seen to disclose or to suggest each and every feature of the invention, at least with respect to the features of programming a PCFI, which comprises a programmable smartcard, adapted to reduce a database search space, using a PCUI, which comprises a user interface including spatially distributed user selectable icons made visible on a surface of the smartcard, wherein the user selectable icons are operable using a smartcard reader to which the smartcard is connected, the PCFI

being programmed by means of user instructions input using the user interface of the PCUI.

Accordingly, Claim 4 is believed to be in condition for allowance. Further, Applicants submit that Claims 5 and 6 are believed to be in condition for allowance for at least the same reasons.

The remaining claims are each dependent from the independent claims discussed above and are therefore believed patentable for the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should be directed to our address given below.

Respectfully submitted,

Attorney for Applicants

Registration No. 39,000

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-2200
Facsimile: (212) 218-2200

CA_MAIN 80606v1